

### **REMARKS/ARGUMENT**

After entering this amendment, claims 1-42, 61-63, and 68-79 will be pending for further prosecution. Claims 68-78 have been added. Claims 1-4, 12-16, 23, 26-29, 31, 32, 36-41, and 61-63 have been amended. Claims 43-60 and 64-67 were cancelled in a previous amendment. No new matter has been added.

#### **Amendment to Specification**

The Applicants amended the specification to delete the phrase “the serial numbers of the deposited currency” to correct an error in the specification. The phrase was deleted from the following sentence in the Description of Related Art Section of the originally filed specification:

Those laws typically specify the type of information to be included in such reports, such as identification of the account to which the deposit was made, the amount of the deposit, the location of the facility where the deposit was made, ~~the serial numbers of the deposited currency,~~ and other useful information.

The Applicants further amended the specification to include a clarifying paragraph from the provisional application to which this application claims the benefit, and which was incorporated by reference. The added paragraph recites, *inter alia*:

The report that is automatically generated by this system includes all the information required by the applicable laws, and can also include the serial numbers and/or the complete images of the currency included in all deposits that exceed the prescribed threshold value.

#### **Claim Rejections – 35 U.S.C. 103(a)**

Claims 1-42 and 61-63 were rejected as being unpatentable over U.S. Patent No. 6,363,164 (“Jones”) in view of U.S. Patent No. 4,774,663 (“Musmanno”) in further view of Applicants’ Admitted Prior Art (found in the specification section entitled “Description of the Related Art”). These rejections are respectfully traversed.

The Office Action relies in part on the Applicants' Admitted Prior Art. The Office Action states that the Applicant's Related Art teaches a report including electronic images and the serial numbers associated with the electronic images of the currency bills. (*See* Page 5 of the Office Action).

The Office Action relies on the unamended "Description of the Related Art" section from the specification as disclosing certain features of the rejected claims. *Id.* However, the amended Description of the Related Art section states only that "[t]hose laws typically specify the type of information to be included in such reports, such as identification of the account to which the deposit was made, the amount of the deposit, the location of the facility where the deposit was made, and other useful information." That is, the corrected specification deletes at least one of the elements relied upon from the Applicants' specification in rejecting claims 1-42 and 61-63. Thus, the rejection of claims 1-42 and 61-63 is improper and should be withdrawn.

Amended independent claim 1 recites, *inter alia*, "wherein the document processing device is configured to include in the automatically generated government-required report one or more of the electronic images, an identification of the specified account at the financial institution to which the deposit is being made, the accumulated total value of the deposit, and the serial numbers associated with the currency bills included in the deposit." (Emphasis added). Additionally, the remaining rejected independent claims (i.e., claims 12, 23, and 32) include a similar report element including serial numbers associated with currency bills or serial numbers extracted from electronic images. For example, independent claim 12 recites, *inter alia*, "the document processing device being further configured to include . . . the serial numbers extracted from the electronic images in the automatically generated government-required report." (Emphasis added).

Based on the above amended disclosure, it is apparent that the prior art relied upon in the Office Action does not typically specify that serial numbers of currency bills are included in the aforementioned reports. Therefore, the Office Action fails to make a *prima facie* case of obviousness. For at least this reason, the rejection of independent claims 1, 12, 23, and 32 based on Jones, Musmanno, Applicants' Description of the Related Art, or any combination thereof, should be withdrawn, and the claims should be in a condition for allowance.

### **New Claims 68-79**

New claims 68-79 include new independent claims 68, 76, and their respective dependent claims 69-75 and 77, along with new independent claim 78. Each of the independent claims generally recites, *inter alia*, generating a report, the report being required by a third party, the generating comprising including in the report at least one denomination, at least one serial number, and at least one image of at least a portion of one of the currency bills. For at least the reasons discussed above, new claims 68-78 should be in a condition for allowance.

New claims 68-79 also include claim 79, which depends from independent claim 12. For at least the reasons discussed above for independent claim 12, dependent claim 79 should be in a condition for allowance.

### **CONCLUSION**

The Applicants submit that claims 1-42, 61-63, and 68-78 are in condition for allowance and action toward that is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (312) 425-8552.

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It is believed that only the extension of time fee is due at this time. No additional fees are believed to be due; however, should any additional fees be required (except for payment of the issue fee), or credits be due, the Commissioner is authorized to deduct the fees from, or credit the overpayments to, the Nixon Peabody Deposit Account No. 50-4181, Order No. 247171-000381USPT.

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Respectfully submitted,

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